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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,714	11/03/2003	Lanny R. Smith	40059-0010	6022

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EXAMINER
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FETSUGA, ROBERT M

ART UNIT	PAPER NUMBER
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3751

DATE MAILED: 10/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

### Office Action Summary

Application No.

10/700,714

Applicant(s)

SMITH, LANNY R.

**Examiner**

**Robert M. Fetsuga**

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2006.  
2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,4,5,7-12 and 15-46 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,7-12 and 15-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/03/03 & 09/20/06 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

1. The drawings are objected to because reference numeral "116" (par. 0022 ln. 11) is missing therefrom. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. Claims 1, 4, 5, 7-12, 15-23, 34-38 and 44-46 are rejected under 35 U.S.C. 112, first paragraph, because the specification,

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while being enabling for an edging constructing apparatus clamped to a form member and wedged to a track, does not reasonably provide enablement for only a form member coupling portion and support member mating portion. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Applicant argues at page 14 of the response filed September 20, 2006 no reasonable basis has been provided to support the non-enablement of the broadly recited invention. The examiner can not agree. Paragraphs 0005 and 0018 of the instant specification, for example, clearly teach what disclosed structure is required to perform the claimed function(s). Absent the spacer 32 and coupling member 60, the form member and support member would necessarily disengage from the swimming pool due to the force of gravity.

3. Claims 8, 12, 18-20, 24-33 and 39-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 is redundant to claim 7/1. The terms "mating" and "coupling" are of the same scope (par. 0005).

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Claim 12 is unclear as to the relationship between the "inner surface" on line 2 thereof, and the "edging forming surface" on line 4 of claim 11.

Claim 18 is unclear as to the relationship between the "protruding form mating portion" on line 2 thereof, and the "protrusion" on line 7 of claim 11.

Claim 19 is unclear as to the relationship between the "protruding support mating portion" on lines 2-3 thereof, and the "track mating feature" on line 5 of claim 11.

Claim 20 is unclear as to the relationship between the "removably secured" feature on line 2 thereof, and the "adapted to removably mate" feature on line 7 of claim 11.

Claim 24 is ambiguous as attempting to embrace two different statutory classes of invention. The claim preamble recites a "method", but the body thereof merely relies upon product/apparatus limitations in support of patentability. See *IPXL Holdings LLC v. Amazon.com Inc.* 77 USPQ2d 1140. Claim 31 is similarly indefinite. Claims 25-30, 32, 33 and 39-43 depend from claims 24 and 31. Applicant argues at page 18 of the response claims 24 and 31 each recite two method steps of "removably coupling". The examiner agrees, however, these steps appear to be representative of known subject matter as indicated by the "black box" depictions in Figs. 6A and 6B (Rule 1.83(a)).

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While the words "removably coupling" and "removably mating", per se, are found in both paragraph 0008 and between paragraphs 0023 and 0024, the method steps associated with these words are not otherwise defined in the specification.

Claim 44 is unclear as to the relationship between the "recess" on line 2 thereof, and the "track mating feature" on line 9 of claim 1.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1, 4, 5, 7-12, 15-23, 35, 36 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Loftin.

The Loftin reference discloses an edging apparatus comprising: a form member including an edge forming portion 54,

a coupling portion 48 and an alignment member 70; a support member 46 including a mating portion having a protrusion (engaging 48), and a pool mating portion having a pool mating feature (portion of 46 at 52); and a coupling member 50, as claimed. Re claim 1, the Loftin form member is "reusable" (i.e. able to be reused). Furthermore, the Loftin edging apparatus is capable of being used with a swimming pool including a pool cover track having a support mating feature as functionally recited in claim 1, for example.

Applicant argues at pages 19-20 of the response the examiner characterized element 52 in Loftin as the claimed track mating portion. The examiner can not agree as the portion of element 46 at element 52 in Loftin was previously and still is characterized as the track mating portion/feature thus establishing anticipation of the claims.

6. Claims 1, 4, 5, 7-12, 15-33, 35, 36, 38, 40 and 42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loftin and Stegmeier '424.

Re claim 24, although the pool mating portion of the Loftin edging constructing apparatus is not coupled to a cover track, as claimed, attention is directed to the Stegmeier '424 ('424) reference (Fig. 3) which discloses an analogous edging constructing apparatus which further includes a pool mating

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portion 37 coupled to a cover track 44. Therefore, in consideration of '424, it would have been obvious to one of ordinary skill in the edging constructing apparatus art to associate cover track coupling with the Loftin pool mating portion in order to construct an edging on a pool of the type enabled to retain a pool cover. Re claim 44, the '424 pool mating portion includes a recess (defined by 38).

Applicant's arguments with respect to claims 24 and 31 at pages 21-23 of the response have been considered but are moot in view of the new ground(s) of rejection.

7. Claims 1, 4, 5, 7-12 and 15-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art and Loftin.

Applicant discloses as admitted prior art (apa) an edging constructing apparatus (and swimming pool), as claimed, except for the form being two separate portions (form/support members) removably coupled by a clamp. Attention is directed to the Loftin reference which discloses an analogous apparatus which further includes a form having two separate portions 26,48 and 46 removably coupled by a clamp 50. Therefore, in consideration of Loftin, it would have been obvious to one of ordinary skill in the edging constructing apparatus art to associate two



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separate portions (form/support members) removably coupled by a clamp with the apa form in order to enable adjustment.

Applicant argues at pages 23-24 of the response Loftin does not teach removably coupling a form member to a support member. The examiner can not agree. The clamp 50 in Loftin removably couples element 48 (which engages the edge forming portion 54) to element 46, which in turn is removably coupled to the pool wall 12.

8. Applicant is referred to MPEP 714.02 and 608.01(o) in responding to this Office action.

9. Any inquiry concerning this communication should be directed to Robert M. Fetsuga at telephone number 571/272-4886 who can be most easily reached Monday through Thursday. The Office central fax number is 571/273-8300.

A handwritten signature in black ink, appearing to read 'Robert M. Fetsuga', is written over the typed name and title.

Robert M. Fetsuga  
Primary Examiner  
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